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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/417,990  | 10/13/1999  | CHRISTOPHER J. LOVETT | MSI-383US           | 8254             |
| 22801   | 7590        | 02/18/2005            | EXAMINER            |                  |
| LEE & HAYES PLLC<br>421 W RIVERSIDE AVENUE SUITE 500<br>SPOKANE, WA 99201 |             |                       | QUELER, ADAM M      |                  |
|   |             |                       | ART UNIT            | PAPER NUMBER     |
|   |             |                       | 2179                |                  |

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/417,990

**Applicant(s)**

LOVETT ET AL.

**Examiner**

Adam M Queler

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 01/27/2005.
2. Claims 30-39 are pending in the case. Claims 30, 34, and 39 are independent claims.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/27/2005 has been entered.

#### ***Response to Declaration - 37 CFR 1.131***

4. The declaration filed on 01/27/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Dougherty and XML Authority references. Specifically the Declaration is insufficient to prove conception prior to the date of the Dougherty reference, and due diligence was not proved for either reference. However, in light of the sufficient evidence of conception prior to the XML Authority's effective date, and to advance prosecution, XML Authority has been removed from the rejection and replaced with a newly found earlier published version of the substantially same rejection.
5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Dougherty reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. MPEPE § 715.07 states "[A] declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a

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statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131." In this case the exhibit is dated 7/7/1999. Therefore, absent further evidence, the declaration is only sufficient to prove conception before 7/7/1999, which does not antedate the Dougherty reference.

6. Assuming *arguendo* that conception occurred before the effective date of the Dougherty reference, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Dougherty reference to either a constructive reduction to practice or an actual reduction to practice. Applicant merely states that the invention was diligently pursued MPEP 715.07(a) states:

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

***Claim Rejections - 35 USC § 103***

7. **Claims 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty, "XML Authority Ends Waiting Games for Schema Developers," and further in view of "XML Authority Product Overview" found at**

**[http://www.extensibility.com/xml\\_authority/xml\\_ath\\_specs.htm](http://www.extensibility.com/xml_authority/xml_ath_specs.htm) (archived 5/8/1999),**

**hereinafter Extensibility, and further in view Applicants Admitted Prior Art.**

**Regarding independent claim 30,** Dougherty teaches converting schema elements into DTD's. Dougherty discloses an editor capable of saving schemas as DTD's (p. 1, para. 4). Dougherty taken as a whole generally describes a product that serves an editor, which allows the user to be able to commit one of the many schema types, while maintaining compatibility with others.

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Dougherty does not teach parsing the document into schema and data elements.

Extensibility teaches, "XML Authority imports schema information residing in existing data structures and documents," including XML documents (p. 2). In order to import the schema information, and since XML documents are text documents, inherently they must be parsed into data and schema elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Dougherty and Extensibility, thereby loading schemas and outputting DTD's, for the purpose of not limiting the user to any particular schema implementation (Dougherty, p. 1, para. 4 and Extensibility, p. 3, "Diverse..."). Additionally, they are both descriptions of the same product.

Applicant admits that DTDs were used to validate data elements (p. 6, ll. 17-21).

Applicant also admits that, in prior art systems, after validation the validation node-factory passes the objects to the tree builder node-factory (p. 6, 17-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the conversion of Extensibility with the prior art validation system of Applicant's Admitted Prior Art since a DTD's primary use was to validate XML documents (Dougherty, p.2, para. 1), it would have been logical to use a system that was known in the art at the time of the invention to facilitate the validation. It would have been further obvious to use this approach since it would not limit the user to any particular schema implementation (Dougherty, p. 1, para. 4 and Extensibility, p. 3, "Diverse...").

**Regarding dependent claim 33**, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

**Regarding independent claim 34**, the architecture for performing the method of claim 1 is rejected under the same rationale.

**Regarding dependent claim 36**, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

**Regarding dependent claim 37**, the client/server for performing the method of claim 14 is rejected under the same rationale.

**Regarding independent claim 39**, the system for performing the method of claim 1 is rejected under the same rationale.

**Regarding dependent claim 38**, Dougherty and Extensibility do not explicitly disclose a node factory but Dougherty does teach that DTD's are used for validation (Dougherty, p.2, para. 1).

Applicant admits it was known in the prior art to use a validation node factory to evaluate whether the data elements comply with constraints set forth in the DTD objects (p. 6, 12-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the conversion of Dougherty and Extensibility with the prior art validation system of Applicant's Admitted Prior Art since a DTD's primary use was to validate XML documents (Dougherty, p.2, para. 1), it would have been logical to use a system that was known in the art at the time of the invention to facilitate the validation. It would have been further obvious to use this approach since it would not limit the user to any particular schema implementation (Dougherty, p. 1, para. 4 and Extensibility, p. 3, "Diverse...").

**8. Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty, Extensibility, and Applicant's Admitted Prior Art as applied to claims 30 and 34 above, and further in view of Hickman et al. (USPN 6564252—filed 3/11/1999).**

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**Regarding dependent claims 32 and 35, Extensibility** is silent as to tables. Hickman et al. (Hickman) discloses tables of schemas (col. 8, ll. 65-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hickman, **Extensibility** and Applicant's Admitted Prior Art in order to provide a place to store the schemas.

9. **Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty, Extensibility, and Applicant's Admitted Prior Art as applied to claim 30 above, and further in view of "Application Programming Interface" found at**

**<http://www.coffeycountyks.org/Terms/2461HTML-126.html> (6/7/1999)**

**hereinafter Coffey.**

**Regarding dependent claim(s) 31,** Dougherty and Extensibility teach converting from schema to DTD as explained in claim 1. Inherent in converting is constructing the DTD objects. Neither Extensibility nor Dougherty teach API's. Coffey teaches an API. It would have been obvious to one of ordinary skill in the art at the time of the invention to call any number of API's, because API's are quicker and easier then developing program from scratch (Coffey).

#### ***Response to Arguments***

10. Applicant's arguments filed 01/27/2005 have been fully considered but they are not persuasive.

The declaration filed on 01/27/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Dougherty and XML Authority references. Specifically the Declaration is insufficient to prove conception prior to the date of the Dougherty reference, and due diligence was not proved for either reference. However, in light of the sufficient evidence of conception prior to the XML Authority's effective date, and to advance prosecution, XML

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Authority has been removed from the rejection and replaced with a newly found earlier published version of the substantially same rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

  
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